REMARKS

Rejection under 35 U.S.C. § 101

Claims 1-6 and 8-13 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Without conceding whether the prior claims produced "a concrete, useful, and tangible result," Applicant has amended claims 1-6 to recite a "computer system" comprising various software interfaces. Applicant has also amended claim 8 to explicitly recite that the method is performed by various software interfaces of a computer system. Claims 9-13 depend from claim 8 and, hence, also require the software interfaces recited in claim 8. Claims 1-6 and 8-13 are clearly directed to statutory subject matter. *See In re Warmerdam*, 31 USPQ2d 1754 (Fed. Cir. 1994).

Rejection under 35 U.S.C. § 102(b)

Claims 1, 8, and 15 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,822,206 to Sebastian et al. (hereinafter Sebastian).

It is well settled that to anticipate a claim, the reference must teach every element of the claim. *See* MPEP § 2131. Moreover, in order for a reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim." *See* MPEP § 2131, citing *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). Furthermore, in order for a reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *See* MPEP § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the cited reference does not satisfy these requirements.

Claim 1 recites, in part:

> a question software interface for capturing a question in a question object that encapsulates text-based information related to a design issue associated with said product design;

an answer software interface for capturing an answer in an answer object that encapsulates text-based information addressing information encapsulated in a selected question object and that is linked to said selected question object; and

a decision software interface for capturing a decision in a decision object that encapsulates text-based information defining a product requirement in response to information in said selected question object and that is linked to said selected question object.

Claim 8 recites, in part:

capturing, by a question software interface of said computer system, a question in a question object that encapsulates text-based information related to a design issue associated with said product design;

capturing, by an answer software interface of said computer system, an answer in an answer object that encapsulates text-based information addressing information encapsulated in a selected question object and that is linked to said selected question object; and

capturing, by a decision software interface of said computer system, a decision in a decision object that encapsulates text-based information defining a product requirement in response to information in said selected question object and that is linked to said selected question object.

Claim 15 recites, in part:

capturing a question in a question object that encapsulates text-based information related to a design issue associated with said product design;

capturing an answer in an answer object that encapsulates text-based information addressing information encapsulated in a selected question object and that is linked to said selected question object; and

capturing a decision in a decision object that encapsulates text-based information defining a product requirement in response to information in said selected question object and that is linked to said selected question object.

The Examiner asserts that the claims "are so broad as to read" on Sebastian. Office Action, page 3. Applicant respectfully traverses the Examiner's assertion. Claims 1, 8, and 15 recite specific data structures or objects that are absent from the disclosure of Sebastian.

Sebastian discloses a design system that includes a "material selector module." The material selector module has access to an expert system that comprises tool and process knowledge. Upon the basis of a defined end-use and environment for a product, the material selector module defines a list of material properties that are relevant to the success of the product. *See* Sebastian, col. 6, lines 14-19. After the list of material properties is generated, queries of existing databases may occur to identify materials that satisfy the requirements. Col. 6, lines 25-36. Accordingly, Sebastian merely discloses a conventional use of databases

for the purpose of identifying materials for a product under design. The Examiner states that the queries in Sebastian satisfy the question objects and the database results in Sebastian satisfy the answer objects. Office Action, pages 3 and 4.

The objects recited in claims 1, 8, and 15 are not merely queries and database results from those queries. Instead, a question object is an object that encapsulates text-based information related to a design issue. An answer object is another object that encapsulates text-based information addressing information encapsulated in a previously captured selected question object. A decision object is yet another object that encapsulates text-based information defining a product requirement in response to information in a previously captured selected question object. By capturing and functionally relating the objects as recited, it is possible to query product design data to gain an understanding how a particular decision was made. Such an understanding enables the product development knowledge generated by a given product design to be applied to new product design efforts in an efficient manner. *See* application, page 8, lines 10-21.

Accordingly, Sebastian does not disclose each and every limitation of claims 1, 8, and 15. These claims are not anticipated by Sebastian.

Rejection under 35 U.S.C. § 103(a)

Claims 2, 4-6, 9, 11-13, 16, and 18-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sebastian in view of U.S. Patent No. 6,295,513 to Thackston (hereinafter Thackston).

Claims 3, 10, and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sebastian, in view of Thackston, and in further view of U.S. Patent Application Publication No. 2002/0012007 by Twigg (hereinafter Twigg).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Applicant asserts that the cited references do not satisfy these criteria.

For the reasons discussed in relation to the rejection under 35 U.S.C. § 102(b), Sebastian does not teach or suggest each and every limitation of claims 1, 8, and 15 (the independent claims of the application). Thackston is merely relied upon for disclosing "data neutrality" (see col. 5, line 47-51 of Thackston) in a "virtual collaborative environment." Twigg is merely relied upon for disclosing multiple databases for design files (see paragraph [0038] of Twigg). Thackston and Twigg do not teach or suggest each and every limitation of claims 1, 8, and 15.

Claims 2-6, 9-13, and 16-19 respectively depend from base claims 1, 8, and 15 and, hence, inherit all limitations of their base claim. The cited references (either alone or in combination) do not teach or suggest each and every limitation of claims 2-6, 9-13, and 16-19. A prima facie case of obviousness has not been established for these claims.

Conclusion

In view of the above amendment, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10003655-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV 482709608US in an envelope addressed to: MS Amendment, Commissioner for Patents, Alexandria, VA 22313.

Date of Deposit: April 28, 2005

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Respectfully submitted,

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